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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,348	01/19/2001	Dewen Qiu	19603/2986 (CRF D-1940B)	7683
7590	04/20/2005		EXAMINER	KUBELIK, ANNE R
Michael L. Goldman NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603			ART UNIT	PAPER NUMBER
			1638	
DATE MAILED: 04/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/766,348	QIU ET AL.
	Examiner Anne R. Kubelik	Art Unit 1638

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 31 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires 5 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): 112, 1<sup>st</sup>, written description and enablement.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 41, 49-51, 53, 58-61, 69-71, 73, 75-77, 80, 82 and 84.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.

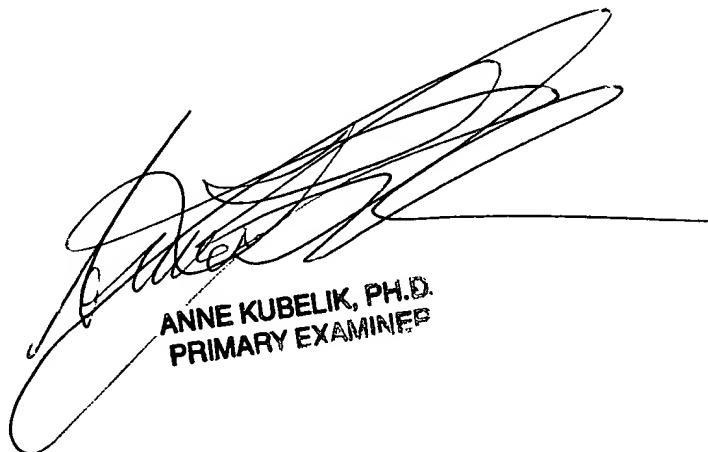
13.  Other: \_\_\_\_\_.

## Continuation of 11:

## 112, 1st, New Matter:

Applicant urges that support for the above-recited phrase appears in the description of the invention at page 36, lines 17-21, which recites "As is conventional in the art, such transgenic plants would contain suitable vectors with various promoters including pathogen-induced promoters, and other components needed for transformation, transcription, and, possibly, translation". Applicant urges that one of ordinary skill in the art would understand the above-recited disclosure to contemplate the use of various promoters, an example of which is pathogen-inducible promoters. The present invention, therefore, also contemplates the use of non-inducible promoters (i.e., constitutive promoters). At the time of filing the present application, one of ordinary skill in the art was well aware of various constitutive promoters used for inducing expression of genes in plants. Applicant urges that the Declaration of Zhong-Min Wei filed August 13, 2004 describes using the constitutive NOS promoter in an *hrpN* transformation construct and that the NOS promoter and other constitutive promoters were well known in the art at the time of filing, citing Koncz et al, U.S. Patent No. 5,034,322, and U.S. Patent No. 5,352,605. Applicant urges that the skilled artisan would have understood the above-recited language to support the use of such non-inducible promoters.

This is not found persuasive. The specification's recitation of "various promoters including pathogen-resistant promoters" does not provide support for any specific type of promoter other than pathogen-inducible promoters, and does not provide support for constitutive promoters. Just because something is known in the art at the time of filing does not mean it was contemplated as part of an invention. At the time of filing, the only promoters contemplated were pathogen-induced promoters or promoters in general, which included pathogen-induced ones.

A handwritten signature in black ink, appearing to read "Anne Kubelik", is overlaid with a large, thin-lined oval. Inside the oval, the text "ANNE KUBELIK, PH.D." is printed in a standard font, and "PRIMARY EXAMINER" is printed below it in a slightly smaller font.

ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER